

REMARKS

Claims 1-15 are pending in the application. Claims 5-8 and 11-14 are now allowed. Claims 1-4, 9, 10 and 15 are rejected. Applicant has amended claim 1.

As a preliminary matter, Applicants wish to express their gratitude for the courtesy extended to the Applicants' undersigned representative during a telephone interview on November 6, 2007 in which the finality of the outstanding Office Action was discussed, the amendment of claim 1 to further distinguish over the prior art was discussed and the patentability of the remaining independent claims was discussed. Applicants appreciate the Examiner's agreement to withdraw the finality of the Office Action and to have the present reply treated as a reply under 37 C.F.R. § 1.111, and the Examiner's indication that the amendments made herein would distinguish over the prior art.

Withdrawal of Final Office Action

Applicants note that the Examiner has made this Office Action final (see page 6), notwithstanding the fact that the Examiner acknowledges that Applicant filed an RCE in the application on July 26, 2007 after final rejection, in order to have entered Applicant's submission filed on May 29, 2007, as stated at page 2 of the Office Action. In the Advisory Action dated June 15, 2007, the Examiner held that the reply filed on May 29, 2007 would not be entered because they raise new issues that would require further consideration and/or a search. In particular, amended claims 1, 5-8 and 15 present new issues. In the present Office Action, claims 1 and 15 are rejected on the basis of the same prior art cited in the previous Action. The Examiner's rationale for holding the present Action final is that all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office Action if they have been entered in the earlier application, citing MPEP §706.07(b).

Applicant respectfully traverses this holding and requests withdrawal of the finality of the first Office Action under MPEP 706.07(c) and (d) because the Examiner held in the Advisory Action that the amended claims 1 and 15 present new issues.

MPEP §706.07(b) expressly provides:

“However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

MPEP §706.07(h), which is specifically directed to the filing of an RCE and the ability of the Examiner to make a first action final after filing of the RCE, expressly provides:

The action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met.

Applicants submit that the Examiner is bound by his holding that new issues are raised in the Amendment filed on May 29, 2007 and cannot make the first Office Action final. Applicants appreciate the Examiner’s agreement with this position in the telephone interview of November 5, 2007 and the Examiner’s indication that the Action should be treated as non-final. Thus, the present reply is treated as a response under 37 C.F.R. § 1.111. If this is not proper, a new non-final Office Action is requested.

Claim Rejections - 35 U.S.C. § 112

Claims 1-4, 9, 10 and 15 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. This rejection is traversed for at least the following reasons.

The Examiner asserts that the claims contain subject matter which was not described in the specification in such a way as to convey to one skilled in the art that the inventors at the time the application was filed, had possession of the claimed invention. In particular, the Examiner points to the recitation in claim 1 that “said disconnecter is supported solely by said insulating frame.” The Examiner asserts that this contradicts the original disclosure where, in Fig. 1, the disconnecter (10b) is supported by the insulating frame (17) but also by the rigid bus-work (26, 27) and it's supporting insulators and by the mechanical linkages (not numbered) connecting the

disconnecter to the vacuum tube rod. The Examiner states that for examination purposes, the quoted feature has not been considered.

In reply, Applicants respectfully note that claim 1 has been amended, via the entered RCE, to state that “a movable element of said disconnecter is supported solely by said insulating frame.” This change was added so that the claim would recite that the movable element (a movable contact blade) of the disconnecter is supported solely by the insulating frame 17.

In further reply to the Examiner’s comment, Applicants respectfully submit that the connectors 26, 27 do not provide “support” for the contact blade. These are simply connectors and offer no structural rigidity or stability for the blade 10b. As to the mechanical linkages (not numbered), these also provide no support, but simply cause movement of the blade 10b.

In order to further clarify the claimed structure, Applicants have amended the claim to state that the movable element of the disconnecter is “rotatably supported at one distal end solely by said insulating frame.” Clearly, this is supported and further distinguishes over the prior art.

Claim Rejection - 35 U.S.C. § 102

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Quenin et al (EP/0,924,827). This rejection is traversed for at least the following reasons.

Quenin et al

The Examiner repeats the basis for rejection from the previous Office Action dated February 27, 2007. In the Response to Arguments at pages 5 and 6, the Examiner states that the limitation “support only by the insulating frame” has not been considered because the originally disclosed invention lacks the feature, as outlined in the rejection under §112. However, if the feature is considered, and even more so with the proposed amendment to the claim, a clear distinction exists over Quenin et al.

With regard to claims 3 and 4, in the previous Amendment, Applicant asserted that Quenin et al illustrates only a single module and that there are no illustrations or teachings of plural stacked modules. The insulators 56, 58 are for separating a fuse structure from the switch module and not for separating two similar switching modules. Applicant argued that the

amended claims state that the hermetic seal is between “adjacent tanks” and would distinguish over the cited reference.

In response to Applicant’s arguments, the Examiner asserts that there is no recitation of a “hermetic seal” in the claims. The Examiner asserts that the claims are broader than argued. However, Applicants respectfully note that claim 3 requires “at least two adjacent tanks being connected to each other via a spacer hermetically connecting said adjacent tanks to define a circuit.” Based on the recited language, it is clear that there is no “spacer hermetically connecting said adjacent tanks to define a circuit” in the reference. Clearly, the claims are not broader than argued but contain a limitation to a spacer that is not found in the prior art, and thus should be allowable.

Similarly, claim 4 requires a “spacer hermetically connecting said adjacent tanks to define a circuit” This feature is not found in the Quenin et al patent.

Claim Rejections - 35 U.S.C. § 103

Claims 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Quenin et al (EP/0,924,827 in view of Tsuzura et al (6,515,247). This rejection is traversed for at least the following reasons.

Claims 9 and 10 depend from claims 3 and 4, respectively. The deficiencies in Quenin et al have already been identified.

Tsuzura

Tsuzura is cited solely for a teaching of a lightning arrester (32) to provide protection from lightning-induced over voltages. Tsuzura does not remedy the deficiencies of Quenin, particularly with regard to the use of “two adjacent tanks being connected to each other via a spacer hermetically connecting said adjacent tanks to define a circuit,” as set forth in claim 3. Similarly distinguish language appears in claim 4.

Applicants would submit that on the basis of the foregoing argument and amendment, the claims are patentable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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